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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,162	09/04/2003	George A. Locko	921042.449	6804

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LERNER AND GREENBERG, PA
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EXAMINER

ZEMEL, IRINA SOPHIA

ART UNIT PAPER NUMBER

1711

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/655,162	LOCKO ET AL.	
	Examiner	Art Unit	
	Irina S. Zemel	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 5-7 and 16-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11-28-2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of invention Group I and terpene-phenol resin in the reply filed on September 14, 2004 is acknowledged. The traversal is on the ground(s) that it is unreasonable and inappropriate to require restriction between a base claim and claims dependent thereupon. This is not found persuasive because applicants argument contradict the accepted US patent practice and the rules that govern the restriction practice. 37 CFR 1.141 states that two or more independent and distinct inventions may not be claimed in one national application. There is nothing in the rule that addresses the form in which the independent inventions are presented. In the previous office action the examiner explicitly set forth the reasons why the claimed inventions are independent and distinct. Those reasons have not been addressed by applicants.

Therefore, the requirement is still deemed proper and is therefore made FINAL.

Claims 3-7 and 16-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention Group II and non-elected phenolic species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on September 14, 2004.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1711

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 8, 12, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 2,284,156 to Lemmer et al., (hereinafter "Lemmer").

Lemmer discloses a process of producing a resin by reacting a rosin and a co-reactant. i.e., terpene-phenol resin in the presence of boric acid (Bronsted acid). The resulting resin has an acid number of less than 20. See illustrative example 1. Among suitable terpenes, limonene, dipenete, etc., are explicitly disclosed in column 3, lines 11-15.

The invention as claimed in claims 1, 2, 8, 12 and 13, thus, is fully anticipated by the disclosure of the Lemmer reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 11, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lemmer.

In addition to the teachings of the Lemmer reference discussed above, the reference discloses 400 parts to 250 parts weight ratio (or 61.5/38.5 %) of the terpene-phenol to rosin in the reaction exemplified in illustrative example 1. This ratio is less than 2 % outside of the claimed ratio. The reference does not specifically address

(outside of the examples) the suitable ratios of the two main components, thus implying that any ratio of the components that will produce desired degree of esterification is suitable for the invention disclosed by Lemmer, with reasonable expectation of adequate results. Therefore, the amounts and ratios as claimed in claim 4 would have been obvious absent showing of unexpected results. The burden is shifted to applicants to provide factual evidence of unexpected results that can be attributed to the differences in the claimed component ratios and ratios disclosed in illustrative example 1.

The reference does not address the softening point (or the molecular weights) of the starting terpene-phenol resin, thus implying that terpene-phenol resins of any softening point (molecular weights) are suitable for the invention with reasonable expectation of adequate results. The reference does not explicitly address the acid number of the rosin modified resins, but exemplifies various esterified terpene-phenol resins with acid numbers corresponding to the claimed number. See example 5. Thus the claimed acid number is within the purview of the reference and would have been obvious with reasonable expectation of adequate results. Further, the reference does not address the final properties of the resin obtained by the process of claim 1, such as softening point molecular weights and color. As far as the color, the reference discusses that resins with very light pale color can be obtained by the disclosed process. See column 1, lines 48-51. Thus, it is believed that the claimed color characteristics are inherently present in the disclosed resins. The other properties, such as molecular weights and softening point are directly related to the properties of the

Art Unit: 1711

initial starting resins. Choosing initial resins with the required softening point and molecular weights would have been obvious for an ordinary artisan with reasonable expectation of adequate results as discussed above. The burden is shifted to applicants to demonstrate that the claimed properties are critical to the claimed invention and produce results unexpected from the teachings of the prior art.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lemmer in combination with US Patent 6,054,606 to Irie et al., (hereinafter "Irie").

The disclosure of the Lemmer reference is discussed above. While the Lemmer reference discloses various suitable Bronsted acid catalysts, the reference does not disclose specifically claimed sulfuric or sulfonic acids, such as p-toluene sulfonic acid. It is well known in the art that various Bronsted acids, including the claimed p-toluene sulfonic acid are usable as dehydration catalysts and are functional equivalents as such catalysts with boric acid explicitly disclosed in the Lemmer reference. See, for example, Irie, column 2 last paragraph. Therefore, it would have been obvious to replace boric acid disclosed in example 1 of Lemmer with p-toluene sulfonic acid as its functional equivalent with reasonable expectation of adequate results.

The inventions as claimed, thus, would have been obvious from the disclosure of the above cited references.

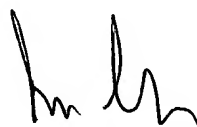
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

Art Unit: 1711

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ISZ



James J. Seidleck
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Technology Center 1700